

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

IN RE APPLICATION OF:	§	ATTY. DOCKET NO.: AUS920030437US1
	§	
DON RUTLEDGE DAY, ET AL.	§	EXAMINER: BRIAN P. WHIPPLE
	§	
SERIAL NO.: 10/631,058	§	CONFIRMATION NO.: 3505
	§	
FILED: 31 JULY 2003	§	ART UNIT: 2152
	§	
FOR: METHOD, SYSTEM AND	§	
PROGRAM PRODUCT FOR	§	
DYNAMIC TRANSMISSION	§	
IN A MESSAGING SESSION	§	

APPEAL BRIEF UNDER 37 C.F.R. 41.37

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Sir:

This Brief is submitted in support of the Appeal of the Examiner's final rejection of Claims 1-21 in the above-identified application. A Notice of Appeal was filed electronically in this case on August 27, 2007 and received in the United States Patent and Trademark Office on August 27, 2007. Please charge the fee of \$510.00 due under 37 C.F.R. §1.17(c) for filing the brief, as well as any additional required fees, to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0461**.

REAL PARTY IN INTEREST

The real party in interest in the present Application is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment set forth at reel 014365, frame 0767.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, the Appellants' legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-21 stand finally rejected by the Examiner as noted in the Final Office Action dated May 25, 2007 ("Final Office Action"). The rejection of Claims 6, 13 and 20 under 35 U.S.C. §102(a) and the rejections of Claims 1-21 under 35 U.S.C. §103(a) are appealed.

STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the May 25, 2007 Final Office Action from which this Appeal is filed.

SUMMARY OF THE CLAIMED SUBJECT MATTER

As set forth in independent **Claim 1**, "a method in a data processing system for managing a messaging session" (supported, for example, in the originally filed specification on p. 6, lines 1-4) includes the steps of:

"a data processing system receiving a plurality of characters from a message sender within the messaging session, wherein the plurality of characters forms a portion of a message within the messaging session" (supported, for example, on p. 14, lines 12-14 and Fig. 4, step 405);

"the data processing system determining that the number of characters of the received plurality of characters is at least equal to a preset number of characters" (supported, for example, at p. 14, lines 13-21 and Fig. 4, step 410); and

“in response to said determining, the data processing system automatically transmitting the plurality of characters to a message recipient within the messaging session without receipt of a send command from the message sender signifying completion of composition of the message” (supported, for example, on p. 15, lines 18-21 and Fig. 4, step 430).

Claim 3 includes all features of Claim 2, plus “wherein the indication is a predefined character appended to the plurality of characters” (supported, for example, on p. 15, line 25 to p. 16, line 2 and Fig. 3 of the originally filed specification). Claim 2 includes all features of Claim 1, plus “wherein the step of transmitting includes transmitting an indication that the transmitted plurality of characters forms only a portion of the message” (supported, for example, on p. 15, lines 21-25 and Fig. 5).

Claim 6 includes all features of Claim 1, and “further comprising the step of determining that the end of the message is not contained within the plurality of characters,” as supported in the original specification, for example, on page 15, line 13-17; and Fig. 4, step 415.

Claim 7 includes all features of Claim 1, plus “wherein the message sender defines the preset number of characters,” as supported in the originally filed specification, for example, on page 14, lines 17-21 and Fig. 3 (see “auto-transmit text characters limit”).

As set forth in independent **Claim 8**, “a data processing system for managing a messaging session” (supported in the originally filed specification, for example, on p. 6, lines 1-4 and p. 7, lines 1-3) comprises:

“means for receiving a plurality of characters from a message sender within the messaging session, wherein the plurality of characters forms a portion of a message within the messaging session” (supported, for example, on p. 14, lines 12-14 and Fig. 4, step 405);

“means for determining that the number of characters of the received plurality of characters is at least equal to a preset number of characters” (supported, for example, at p. 14, lines 13-21 and Fig. 4, step 410); and

“means, responsive to said determining, for automatically transmitting the plurality of characters to a message recipient within the messaging session without receipt of a send

command from the message sender signifying completion of composition of the message” (supported, for example, on p. 15, lines 18-21 and Fig. 4, step 430).

Claim 10 includes all features of Claim 9, plus “wherein the indication is a predefined character appended to the plurality of characters” (supported, for example, on p. 15, line 25 to p. 16, line 2 and Fig. 3 of the originally filed specification). Claim 9 includes all features of Claim 8, plus “wherein the means for transmitting includes transmitting an indication that the transmitted plurality of characters forms only a portion of the message” (supported, for example, on p. 15, lines 21-25 and Fig. 5).

Claim 13 includes all features of Claim 8, and “further comprising means for determining that the end of the message is not contained within the plurality of characters,” as supported in the original specification, for example, on page 15, line 13-17; and Fig. 4, step 415.

Claim 14 includes all features of Claim 8, plus “wherein the message sender defines the preset number of characters,” as supported in the originally filed specification on, for example, page 14, lines 17-21 and Fig. 3 (see “auto-transmit text characters limit”).

As set forth in independent **Claim 15**, “an article of manufacture comprising a volatile or non-volatile machine-readable medium including program logic encoded therein,” supported in the originally filed specification, for example, on p. 11, line 4 to p. 12, line 6 that causes a data processing system to perform the steps of:

“receiving a plurality of characters from a message sender within the messaging session, wherein the plurality of characters forms a portion of a message within the messaging session” (supported, for example, on p. 14, lines 12-14 and Fig. 4, step 405);

“determining that the number of characters of the received plurality of characters is at least equal to a preset number of characters” (supported, for example, on p. 14, lines 13-21 and Fig. 4, step 410); and

“in response to said determining, automatically transmitting the plurality of characters to a message recipient within the messaging session without receipt of a send command from the

message sender signifying completion of composition of the message” (supported, for example, on p. 15, lines 18-21 and Fig. 4, step 430).

Claim 17 includes all features of Claim 16, plus “wherein the indication is a predefined character appended to the plurality of characters” (supported, for example, on p. 15, line 25 to p. 16, line 2 and Fig. 3 of the originally filed specification). Claim 16 includes all features of Claim 15, plus “wherein the step of transmitting includes transmitting an indication that the transmitted plurality of characters forms only a portion of the message” (supported, for example, on p. 15, lines 21-25 and Fig. 5).

Claim 20 includes all features of Claim 15, and “further comprising the step of determining that the end of the message is not contained within the plurality of characters,” as supported in the original specification, for example, on page 15, line 13-17; and Fig. 4, step 415.

Claim 21 includes all features of Claim 15, plus “wherein the message sender defines the preset number of characters,” as supported in the originally filed specification, for example, on page 14, lines 17-21 and Fig. 3 (see “auto-transmit text characters limit”).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. The Examiner’s rejection of Claims 1-2, 4-6, 8-9, 11-13, 15-16 and 18-20 under 35 U.S.C. §103(a) as being unpatentable over *QuikTxT* in view of *Enete et al.* (U.S. Publication No. 2003/0208543 A1 – “*Enete*”) is to be reviewed on Appeal.
- B. The Examiner’s rejection of Claims 3, 10 and 17 under 35 U.S.C §103(a) as being unpatentable over *QuikTxT* in view of *Enete* in further view of *Malik et al.* (U.S. Publication No. 2005/0044144 A1 – “*Malik*”) is to be reviewed on Appeal.
- C. The Examiner’s rejection of Claims 7, 14 and 21 under 35 U.S.C. §103(a) as being unpatentable over *QuikTxT* in view of *Enete* in further view of *Horvitz et al.* (U.S. Publication No. 2003/0046421 A1 – “*Horvitz*”) is to be reviewed on Appeal.

ARGUMENTS

- A. The Examiner's rejection of Claims 1-2, 4-6, 8-9, 11-13, 15-16 and 18-20 under 35 U.S.C. §103(a) as being unpatentable over *QuikTxT* in view of *Enete* is to be reviewed on Appeal.

The Examiner's rejection of Claims 1-2, 4-6, 8-9, 11-13, 15-16 and 18-20 is improper because there is no objective evidence of records that would have led a person having ordinary skill in the art to combine the cited references to achieve the claimed invention. Specifically, modifying *QuikTxT* with *Enete* changes the principle of operation of *QuikTxT*.

Regarding the rejection of exemplary Claim 1, the combination of *QuikTxT* and *Enete* does not render obvious the step of "in response to said determining, the data processing system automatically transmitting the plurality of characters to a message recipient within the messaging session without receipt of a send command from the message sender signifying completion of composition of the message", as claimed. The Examiner states, "*QuikTxT* is silent on in response to said determining, the data processing system automatically transmitting the plurality of characters to a message recipient within the messaging session without receipt of a send command from the message sender signifying completion of composition of the message" (Final Office Action, p. 5, paragraph 10). However, *QuikTxT* instructs the message sender to "fill in the 10-digit mobile number, your message, from and callback/reply; then click 'Send Message'" (*QuikTxT*, p. 2, paragraph 2). *QuikTxT* also teaches that once the send command is issued, any message over 160 characters will be split into multiple messages. If a message is more than 640 characters, the message will be cut-off at that point. (*QuikTxT*, p.2, paragraph 6). Therefore, the principle of operation of *QuikTxT* relies upon a send command to transmit a plurality of characters to a message recipient.

To provide the missing teaching in *QuikTxT*, the Examiner relies on *Enete*, which the Examiner states "is directed to determining that a video message has reached a size limit and

then sending the portion that reaches the limit, while allowing the user to continue to record without user intervention”, (p. 5-6, paragraph 10). Specifically, the Examiner cites *Enete* at paragraph 0077, lines 13-17, which recites:

For example, the sender may not be able to record a video message longer than 15 seconds. The client **602a** may be configured, however, to automatically send a video message when the limit is read and to begin recording another video message without user intervention.

The Examiner states on p. 6 of the Final Office Action that, “It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *QuikTxT* by automatically transmitting a portion of a message without receipt of a send command from the message sender signifying completion of composition of the message as taught by *Enete* in order to allow a user to conform to message size limits while continuing to compose a long message uninterrupted” (emphasis added). However, *QuikTxT* teaches using a send command to send the message when it is complete. Furthermore, *QuikTxT* relies upon the send command to determine whether to split a message into multiple messages and whether to truncate a message longer than 640 characters. Without receipt of a send command, *QuikTxT* is unable to split a large message into multiple messages or truncate a message that exceeds 640 characters. Modifying *QuikTxT* to send a message without receipt of a send command would thereby change the principle of operation of *QuikTxT*. (*QuikTxT*, p.2, paragraph 2 and paragraph 6). On the other hand, *Enete* teaches automatically send a video message when the limit is read and to begin recording another video message without user intervention (paragraph 0077, lines 13-17). Modifying *Enete* to rely upon a send command to determine whether to split a message into multiple messages would thereby change the principle of operation of *Enete*. It would therefore not be obvious to one skilled in the art to modify *QuikTxT* with *Enete* to achieve the claimed invention.

Regarding the rejection of independent Claims 8 and 15, the Examiner states, “As to claims 8 and 15, the claims are rejected for the same reasons as claim 1 above” (Final Office Action, p. 8, paragraph 15). The argument put forth supra regarding the rejection of independent Claim 1 is dispositive of the rejection of Claims 8 and 15. Claims 2, 4-6, 9, 11-13, 16 and 18-20

depend directly or indirectly from independent Claims 1, 8 and 15. The argument put forth supra regarding the rejection of independent Claim 1 is dispositive of the rejection of Claims 2, 4-6, 9, 11-13, 16 and 18-20. For the reasons cited above, the rejection of Claims 1-2, 4-6, 8-9, 11-13, 15-16 and 18-20 is improper, and should be reversed.

B. The Examiner's rejection of Claims 3, 10 and 17 under 35 U.S.C. §103(a) as being unpatentable over *QuikTxT* in view of *Enete* in further view of *Malik* is to be reviewed on Appeal.

1. The Examiner's rejection of Claims 3, 10 and 17 is improper because the combination of *QuikTxT*, *Enete* and *Malik* does not render obvious the feature of transmitting an indication that the transmitted plurality of characters forms only a portion of the message, wherein the indication is a predefined character appended to the plurality of characters.

Regarding the rejection of exemplary Claim 3, the combination of *QuikTxT*, *Enete* and *Malik* does not render obvious, “transmitting an indication that the transmitted plurality of characters forms only a portion of the message,” wherein, “the indication is a predefined character appended to the plurality of characters”, as claimed. The Examiner states in paragraph 21 of the Final Office Action that the combination of *QuikTxT* and *Enete* is “silent on the indication is a predefined character appended to the plurality of characters.” The Examiner interprets *Malik* at paragraph [0053], lines 1-20 as disclosing the indication as a predefined character appended to a plurality of characters. However, the cited portion of *Malik* teaches adding an additional character to a domain name, not a portion of a message, as claimed. Furthermore, the additional characters disclosed by *Malik* are used to “identify [the user] as being registered under the Universal IM server 425” (para. [0053], lines 3-4). The additional characters are not used as “an indication that a transmitted plurality of characters forms only a portion of a message”, as claimed. The claimed invention would therefore not be obvious to one skilled in the art in view of the combination of *QuikTxT* and *Malik*.

The Examiner states on page 4 at paragraph 6, “the argument that *Malik* is directed to a different indication than the claimed invention is also not convincing as claim 3 merely states that there is an indication.” However, Claim 3 does not merely claim that there is an indication. Claim 3 depends from Claim 2, and “the indication” of Claim 3 has antecedent basis to the indication of Claim 2, specifically “an indication that the transmitted plurality of characters forms only a portion of the message.” *Malik* does not teach such an indication as claimed. Therefore the combination of *QuikTxT*, *Enete* and *Malik* does not render obvious “transmitting an indication that the transmitted plurality of characters forms only a portion of the message,” wherein, “the indication is a predefined character appended to the plurality of characters”, as claimed.

2. The Examiner’s rejection of Claims 3, 10 and 17 is improper because improper because there is no objective evidence of record that would have led a person having ordinary skill in the art to combine the cited references to achieve the claimed invention. Specifically, modifying *QuikTxT* with *Enete* changes the principle of operation of *QuikTxT*.

Claims 3, 10 and 17 depend directly or indirectly from independent Claims 1, 8 and 15, which have been improperly rejected in view of the cited art. The rejection of Claims 3, 10 and 17 are likewise improper and should be reversed in view of the arguments put forth supra regarding the rejection of independent Claims 1, 8 and 15.

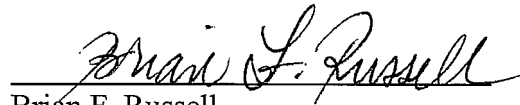
C. The Examiner’s rejection of Claims 7, 14 and 21 under 35 USC 103(a) as being unpatentable over *QuikTxT* in view of *Enete* in further view of *Horvitz et al.* (U.S. Publication No. 2003/0046421 A1 – “*Horvitz*”) is to be reviewed on Appeal.

Claims 7, 14 and 21 depend directly or indirectly from independent Claims 1, 8 and 15, which have been improperly rejected in view of the cited art. The rejection of Claims 7, 14 and 21 is likewise improper and should be reversed in view of the arguments put forth supra regarding the rejection of independent Claims 1, 8 and 15.

CONCLUSION

Appellants have pointed out with specificity the manifest error in the Examiner's rejections, and the claim language which renders the invention patentable over the various combinations of references. Appellants, therefore, respectfully request the reversal of the rejections of all pending claims.

Respectfully submitted,

A handwritten signature in cursive script, reading "Brian F. Russell", written over a horizontal line.

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CLAIMS APPENDIX

1. A method in a data processing system for managing a messaging session, said method comprising the steps of:

a data processing system receiving a plurality of characters from a message sender within the messaging session, wherein the plurality of characters forms a portion of a message within the messaging session;

the data processing system determining that the number of characters of the received plurality of characters is at least equal to a preset number of characters; and

in response to said determining, the data processing system automatically transmitting the plurality of characters to a message recipient within the messaging session without receipt of a send command from the message sender signifying completion of composition of the message.

2. The method according to claim 1, wherein the step of transmitting includes:

transmitting an indication that the transmitted plurality of characters forms only a portion of the message.

3. The method according to claim 2, wherein the indication is a predefined character appended to the plurality of characters.

4. The method according to claim 1, said method further comprising the steps of:

concatenating another plurality of characters that forms a portion of the message to the transmitted plurality of characters, thereby creating concatenated characters; and

transmitting the concatenated characters to the message recipient within the messaging session.

5. The method according to claim 4, said method further comprising the step of:

determining that the number of characters of the another plurality of characters is at least equal to a preset number of characters; and

wherein the step of concatenating is performed once it is determined that the number of characters of the another plurality of characters is at least equal to the preset number of characters.

6. The method according to claim 1, further comprising the step of determining that the end of the message is not contained within the plurality of characters.

7. The method of claim 1, wherein the message sender defines the preset number of characters.

8. A data processing system for managing a messaging session, said system comprising:

means for receiving a plurality of characters from a message sender within the messaging session, wherein the plurality of characters forms a portion of a message within the messaging session;

means for determining that the number of characters of the received plurality of characters is at least equal to a preset number of characters; and

means, responsive to said determining, for automatically transmitting the plurality of characters to a message recipient within the messaging session without receipt of a send command from the message sender signifying completion of composition of the message.

9. The data processing system according to claim 8, wherein the means for transmitting includes:

transmitting an indication that the transmitted plurality of characters forms only a portion of the message.

10. The data processing system according to claim 9, wherein the indication is a predefined character appended to the plurality of characters.

11. The data processing system according to claim 8, further comprising means for:

means for concatenating another plurality of characters that forms a portion of the message to the transmitted plurality of characters, thereby creating concatenated characters; and

means for transmitting the concatenated characters to the message recipient within the

messaging session.

12. The data processing system according to claim 11, further comprising:

means for determining that the number of characters of the another plurality of characters is at least equal to a preset number of characters; and

wherein the step of concatenating is performed once it is determined that the number of characters of the another plurality of characters is at least equal to the preset number of characters.

13. The data processing system according to claim 8, further comprising means for determining that the end of the message is not contained within the plurality of characters.

14. The data processing system according to claim 8, wherein the message sender defines the preset number of characters.

15. An article of manufacture comprising a volatile or non-volatile machine- readable medium including program logic encoded therein that causes a data processing system to perform the steps of:

receiving a plurality of characters from a message sender within the messaging session, wherein the plurality of characters forms a portion of a message within the messaging session;

determining that the number of characters of the received plurality of characters is at least equal to a preset number of characters; and

in response to said determining, automatically transmitting the plurality of characters to a message recipient within the messaging session without receipt of a send command from the message sender signifying completion of composition of the message.

16. The article of manufacture of Claim 15, wherein the step of transmitting includes:

transmitting an indication that the transmitted plurality of characters forms only a portion of the message.

17. The article of manufacture of Claim 16, wherein the indication is a predefined character

appended to the plurality of characters.

18. The article of manufacture of Claim 15, further comprising the steps of:
concatenating another plurality of characters that forms a portion of the message to the transmitted plurality of characters, thereby creating concatenated characters; and
transmitting the concatenated characters to the message recipient within the messaging session.

19. The article of manufacture of Claim 18, further comprising the step of:
determining that the number of characters of the another plurality of characters is at least equal to a preset number of characters; and
wherein the step of concatenating is performed once it is determined that the number of characters of the another plurality of characters is at least equal to the preset number of characters.

20. The article of manufacture of Claim 15, further comprising the step of:
determining that the end of the message is not contained within the plurality of characters.

21. The article of manufacture of Claim 15, wherein the message sender defines the preset number of characters.

EVIDENCE APPENDIX

Other than the Office Action(s) and reply(ies) already of record, no additional evidence has been entered by Appellants or the Examiner in the above-identified application which is relevant to this appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings as described by 37 C.F.R. §41.37(c)(1)(x) known to Appellants, Appellants' legal representative, or assignee.